

I hereby certify that this correspondence is being transmitted to the  
United States Patent and Trademark Office through EFS-Web on:  
September 5, 2008.

**PATENT APPLICATION**

Reinhart Boerner Van Deuren S.C.

By: /Leslie S. Miller/  
Leslie S. Miller

Date: September 5, 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT: 3622

EXAMINER: NAMRATA BOVEJA

In re application of: Carlos G. )  
Gonzales-Rivas )  
 )  
Application No: 09/882,511 )  
 )  
Confirmation No.: 8335 )  
 )  
Filed: June 15, 2001 )  
 )  
Attorney Docket No. 6511 )  
 )  
Customer No.: 22922 )

For: OFFLINE TO ONLINE  
MARKETING PROGRAM TO  
INCENTIVIZE TELEVISION  
VIEWERS TO PARTICIPATE  
IN AN INTERACTIVE  
INTERNET CONTEST

Commissioner for Patents  
Mail Stop Appeal Brief - Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

September 5, 2008

APPEAL BRIEF

Sir:

Appellant, pursuant to 37 C.F.R. § 41.37, hereby files this Appeal Brief as part of  
the appeal on the above-referenced patent application.

**I. Real Party in Interest**

The real party in interest in this application is New Commerce Marketing, Inc., the recorded assignee of the entire title of the subject application.

**II. Related Appeals and Interferences**

None.

**III. Status of Claims**

Claims 1-28, including **Independent Claims 1, 25, 26, 27, and 28**, are pending in the case, and are all finally rejected. Claims 1-28 are the subject of this appeal, and a copy of these claims is attached hereto as the Claims Appendix.

**IV. Status of Amendments**

A September 6, 2007, Amendment A was the last amendment to be made to the claims, and was entered and considered. There was no post rejection amendment, leaving Claims 1-28 pending.

**V. Summary of Claimed Subject Matter**

Twenty-eight (28) claims including five (5) independent claims directed toward a method of increasing consumer awareness of products or services which are advertised in television commercials are involved in this appeal. Appellant regards as his invention a

marketing method that displays a distinctive logo identifying a particular marketing website during a television commercial. Consumers who have viewed the commercial can log onto the marketing website identified by the logo and participate in an interactive online game or contest that will increase the consumers' awareness of the advertised product or service and thereby reinforce the offline television advertising seen by them. Once a consumer logs onto the marketing website, the consumer must select the particular enhanced television commercial viewed by the consumer from a series of screens displayed to the consumer on the marketing website. This selection process:

1. displays a list of television networks on which the television commercial has aired;
2. prompts the consumer to select the particular television network on which the consumer viewed the particular commercial;
3. displays to the consumer a list of television shows broadcasted by the particular television network during which the commercial has been broadcasted;
4. prompts the consumer to select the particular television show on which the consumer viewed the television commercial;
5. displays to the consumer a list of television commercials which were broadcasted during the particular television show; and
6. prompts the consumer to select the particular commercial.

The marketing website then provides a game or contest for the consumer to play that provides information on or relates to the particular product or service advertised by the particular commercial.

A concise explanation of the subject matter defined in each of the five independent claims will be described below, together with references to the specification of the application as filed by page, paragraph, and line numbers of the paragraph (not the line number on the page), and to the drawings by reference numerals. For ease of readability, only one reference to the drawings and to the specification by page, paragraph, and line number is made for each claim term or phrase. Each subsequent reference to a claim term typically includes the reference character for ready reference. There is no intent to limit the claims in any manner by references, as this is merely being done for compliance with the Appeal rules.

**Claim 1.** Independent Claim 1 is involved in this appeal and is directed toward a method of increasing consumer awareness of products or services which are advertised in television commercials. The method comprises the following steps:

(a) enhancing a plurality of television commercials (70, 72, and 74 in FIG. 5, pg. 21, paragraph 56, line 30 to pg. 22, line 3) by displaying a marketing website logo (66 in FIGS. 4, 7-16, pg. 22, paragraph 56, lines 1-2) during each of said plurality of enhanced television commercials;

(b) providing a marketing website (58 in FIG. 3, 82, 84, and 86 in FIG. 5, FIG. 7, pg. 22, paragraph 58, line 18 to pg. 23, paragraph 59, line 9) which is associated with and identified by said marketing website logo and which is accessible by consumers;

(c) displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a list of television networks on which enhanced television commercials have aired (88 in FIG. 5, FIGS. 8 and 9, pg. 23, paragraph 59, line 9 to paragraph 60, line 25), and prompting the consumer to select the particular television network on which the consumer viewed the particular enhanced television commercial (104 and 112 in FIG. 5, FIGS. 8 and 9, pg. 24, paragraph 62, line 10 to paragraph 63, line 30);

(d) displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows enhanced television commercials have been broadcasted (114 in FIG. 5, FIG. 10, pg. 24, paragraph 63, line 30 to paragraph 64, line 24), and prompting the consumer to select the particular television show during which the consumer viewed the particular enhanced television commercial (144 and 148 in FIG. 5, FIG. 10, pg. 25, paragraph 65, line 25, to pg. 26, paragraph 66, line 11);

(e) displaying to the consumer a list of enhanced television commercials which were broadcasted during the particular television show (150 in FIG. 5, FIG. 11, pg. 26, paragraph 66, lines 11-34), and prompting the consumer to select the particular enhanced television commercial (166 and 170 in FIG. 5, FIG. 11, pg. 27, paragraph 68, line 1 to paragraph 69, line 16); and

(f) providing a game or contest for the consumer to play (192 in FIG. 6, FIG. 14, page 29, paragraph 74, lines 11-19) which game or contest provides information on or relates to the particular product or service advertised by the particular enhanced television commercial (page 11, paragraph 22, line 10 to page 12, paragraph 24, line 13).

**Claim 4.** Dependent Claim 4 is involved in this appeal and comprises the following additional step:

enhancing printed materials (64 in FIG. 4, page 21, paragraph 55, lines 15-17) which are transmitted to consumers by printing said marketing website logo (66 in FIG. 4, page 21, paragraph 55, line 17) thereupon.

**Claim 7.** Dependent Claim 7 is involved in this appeal and comprises the following additional steps:

(a) printing said marketing website logo (66 in FIG. 4, page 21, paragraph 55, line 17) on at least one type of printed material (64 in FIG. 4, page 21, paragraph 55, lines 15-17) which is provided to consumers, and

(b) displaying, simultaneously with said step of displaying a list of television networks (88 in FIG. 5, FIGS. 8 and 9, pg. 23, paragraph 59, line 9 to paragraph 60, line 25), a readily recognizable logo or other indicia (102 in FIGS. 8 and 9, paragraph 61, page 23, lines 26-33), that identifies said type of printed material.

**Claim 25.** Independent Claim 25 is involved in this appeal and is directed toward a method of increasing consumer awareness of a product or service which is advertised in a television commercial. The method comprises the following steps:

(a) displaying a marketing website logo during the television commercial (72 in FIG. 5, pg. 21, paragraph 56, line 33 to pg. 22, line 3, 66 in FIGS. 4, 7-16, pg. 22, paragraph 56, lines 1-2);

(b) providing a marketing website (58 in FIG. 3, 82, 84, and 86 in FIG. 5, FIG. 7, pg. 22, paragraph 58, line 18 to pg. 23, paragraph 59, line 9) which is associated with and identified by said marketing website logo and which is accessible by consumers;

(c) displaying to a consumer who has entered said marketing website in response to viewing the television commercial a list of television networks on which television commercials which display said marketing website logo have been broadcasted (88 in FIG. 5, FIGS. 8 and 9, pg. 23, paragraph 59, line 9 to paragraph 60, line 25), and prompting the consumer to select the television network on which the consumer viewed the television commercial (104 and 112 in FIG. 5, FIGS. 8 and 9, pg. 24, paragraph 62, line 10 to paragraph 63, line 30);

(d) in response to the consumer's selection of a particular television network, displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows television commercials which display said marketing website logo have been broadcasted (114 in FIG. 5, FIG. 10, pg. 24,

paragraph 63, line 30 to paragraph 64, line 24), and prompting the consumer to select the television show during which the consumer viewed the television commercial (144 and 148 in FIG. 5, FIG. 10, pg. 25, paragraph 65, line 25, to pg. 26. paragraph 66, line 11);

(e) in response to the consumer's selection of a particular television show, displaying to the consumer a list of television commercials which display said marketing website logo and which were broadcasted during the selected television show (150 in FIG. 5, FIG. 11, pg. 26, paragraph 66, lines 11-34), and prompting the consumer to select the television commercial (166 and 170 in FIG. 5, FIG. 11, pg. 27, paragraph 68, line 1 to paragraph 69, line 16); and

(f) in response to the consumer's selection of the television commercial, providing a game or contest for the consumer to play (192 in FIG. 6, FIG. 14, page 29, paragraph 74, lines 11-19) which game or contest provides information on or relates to the particular product or service advertised by the television commercial (page 11, paragraph 22, line 10 to page 12, paragraph 24, line 13).

**Claim 26.** Claim 26 is involved in this appeal and is directed toward a method of increasing consumer awareness of products or services which are advertised in television commercials. The method comprises the following steps:

(a) enhancing a plurality of television commercials (70, 72, and 74 in FIG. 5, pg. 21, paragraph 56, line 30 to pg. 22, line 3) by displaying a marketing website logo (66



in FIGS. 4, 7-16, pg. 22, paragraph 56, lines 1-2) during each of said plurality of enhanced television commercials;

(b) providing a marketing website (58 in FIG. 3, 82, 84, and 86 in FIG. 5, FIG. 7, pg. 22, paragraph 58, line 18 to pg. 23, paragraph 59, line 9) which is associated with and identified by said marketing website logo and which is accessible by consumers;

(c) displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a list of television networks on which enhanced television commercials have aired (88 in FIG. 5, FIGS. 8 and 9, pg. 23, paragraph 59, line 9 to paragraph 60, line 25), and prompting the consumer to select the particular television network on which the consumer viewed the particular enhanced television commercial (104 and 112 in FIG. 5, FIGS. 8 and 9, pg. 24, paragraph 62, line 10 to paragraph 63, line 30);

(d) in response to the consumer's selection of a particular television network, displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows enhanced television commercials have been broadcasted (114 in FIG. 5, FIG. 10, pg. 24, paragraph 63, line 30 to paragraph 64, line 24), and prompting the consumer to select the particular television show during which the consumer viewed the particular enhanced television commercial (144 and 148 in FIG. 5, FIG. 10, pg. 25, paragraph 65, line 25, to pg. 26, paragraph 66, line 11);

(e) in response to the consumer's selection of a particular television show, displaying to the consumer a list of enhanced television commercials which were broadcasted during the particular television show (150 in FIG. 5, FIG. 11, pg. 26, paragraph 66, lines 11-34), and prompting the consumer to select the particular enhanced television commercial (166 and 170 in FIG. 5, FIG. 11, pg. 27, paragraph 68, line 1 to paragraph 69, line 16); and

(f) in response to the consumer's selection of the particular enhanced television commercial, providing a game or contest in which the consumer may play for a prize or award (192 in FIG. 6, FIG. 14, page 29, paragraph 74, lines 11-19), which game or contest provides information on or relates to the particular product or service advertised by the particular enhanced television commercial (page 11, paragraph 22, line 10 to page 12, paragraph 24, line 13).

**Claim 27.** Claim 27 is involved in this appeal and is directed toward a method of enhancing the marketing of products or services which are advertised in television commercials. The method comprises the following steps:

(a) providing a marketing website (58 in FIG. 3, 82, 84, and 86 in FIG. 5, FIG. 7, pg. 22, paragraph 58, line 18 to pg. 23, paragraph 59, line 9) which is associated with an indicia (66 in FIGS. 4, 7-16, pg. 22, paragraph 56, lines 1-2) and which is accessible by consumers;

(b) enhancing a plurality of television commercials (70, 72, and 74 in FIG. 5, pg. 21, paragraph 56, line 30 to pg. 22, line 3) by displaying said indicia which is associated with said marketing website during each of said plurality of enhanced television commercials;

(c) providing incentives (page 20, paragraph 53, lines 17-34) to motivate consumers to enter said marketing website in response to viewing enhanced television commercials;

(d) displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a series of screens (70, 72, 74, 114, and 150 in FIG. 5, FIG. 10, FIG. 11, pg. 21, paragraph 56, line 30 to pg. 22, line 3, pg. 24, paragraph 63, line 30 to paragraph 64, line 24, pg. 26, paragraph 66, lines 11-34) which prompt the consumer to select the particular enhanced television commercial viewed by the consumer (104, 112, 144, 148, 166, and 170 in FIG. 5, FIGS. 8-, pg. 24, paragraph 62, line 10 to paragraph 63, line 30, pg. 25, paragraph 65, line 25, to pg. 26, paragraph 66, line 11, pg. 27, paragraph 68, line 1 to paragraph 69, line 16); and

(e) providing marketing information relating to the product advertised by the particular enhanced television commercial viewed by the consumer in a manner which is associated with said incentives (page 11, paragraph 22, line 10 to page 12, paragraph 24, line 13).

**Claim 28.** Claim 28 is involved in this appeal and is directed toward a method of marketing products or services. The method comprises the following steps:

(a) providing a marketing website (58 in FIG. 3, 82, 84, and 86 in FIG. 5, FIG. 7, pg. 22, paragraph 58, line 18 to pg. 23, paragraph 59, line 9) having a particular web address;

(b) broadcasting said web address in conjunction with each of a plurality of television commercials (72 in FIG. 5, pg. 21, paragraph 56, line 33 to pg. 22, line 3, 66 in FIGS. 4, 7-16, pg. 22, paragraph 56, lines 1-2);

(c) first, allowing a consumer entering said marketing website to select the particular television network on which the consumer viewed a particular one of said plurality of television commercials (88, 104, and 112 in FIG. 5, FIGS. 8 and 9, pg. 23, paragraph 59, line 9 to paragraph 60, line 25, pg. 24, paragraph 62, line 10 to paragraph 63, line 30);

(d) second, allowing the consumer to select the particular television show during which the consumer viewed said particular television commercial (114, 144, and 148 in FIG. 5, FIG. 10, pg. 24, paragraph 63, line 30 to paragraph 64, line 24, pg. 25, paragraph 65, line 25, to pg. 26. paragraph 66, line 11);

(e) third, allowing the consumer to select said particular television commercial (150, 166, and 170 in FIG. 5, FIG. 11, pg. 26, paragraph 66, lines 11-34, pg. 27, paragraph 68, line 1 to paragraph 69, line 16); and

(f) fourth, providing marketing information relating to the product advertised by the particular enhanced television commercial in a manner which the consumer finds gratifying (page 11, paragraph 22, line 10 to page 12, paragraph 24, line 13).

## **VI. Grounds of Rejection to be Reviewed on Appeal**

1. Claims 1-3, 6, and 8-11, including **Independent Claim 1**, stand rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled Bacardi Brings Out the Bottle in Cable-TV Ad for Amaretto --- Spot Is Firm's First to Blatantly Display Product, Vanessa O'Connell, Wall Street Journal (Europe, Brussels, May 2, 2001, page 25 (hereinafter "O'Connell")) in view of the article titled Job-Hunting Web Sites' Ads Will Duel at Super Bowl, Rachel Emma Silverman and Suzanne Vranica, Wall Street Journal (Eastern Edition), New York, NY, January 23, 2001, page B.8 (hereinafter "Silverman et al."), and Official Notice.

2. Although it is not specifically rejected, the Examiner infers that there is an antecedent basis issue in Claim 4 (this issue will be referred to herein as the inferred 35 U.S.C. Section 112, second paragraph rejection).

3. Claim 7 stands rejected under 35 U.S.C. Section 112, second paragraph, as being "unclear."

4. Claims 4, 5, and 7 were rejected were rejected under 35 U.S.C. Section 103(a) as being unpatentable over O'Connell in view of Silverman et al. and the printout

of a page from Monster.com obtained from the Internet Archive WayBack Machine dated April 18, 2001, at <http://web.archive.org/web/20010418150929/momentum.monster.com/> (hereinafter "Monster.com"), and Official Notice.

5. Claims 12-26, including **Independent Claims 25 and 26**, were rejected were rejected under 35 U.S.C. Section 103(a) as being unpatentable over O'Connell in view of Silverman et al., Lesandrini et al. (U.S. Patent Application Publication No. 2003/0036944), and Official Notice.

6. **Independent Claim 27** was rejected under 35 U.S.C. Section 103(a) as being unpatentable over O'Connell in view of Silverman et al., Monster.com, and Official Notice.

7. **Independent Claim 28** was rejected under 35 U.S.C. Section 103(a) as being unpatentable over O'Connell in view of Monster.com and Official Notice.

## **VII. Argument**

Prior to turning to the merits of the rejection, Appellant notes the issue for the Board to decide in this appeal is whether the cited references in conjunction with Official Notice render the subject matter of any of the rejected claims as a whole obvious within the meaning of 35 U.S.C. Section 103(a). In deciding this issue, the Board needs to make that determination on the basis of the entire record, taking into account the relative

persuasiveness of argument. As explained in In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (citations omitted):

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

"After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.

"If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent."

**A. The Rejection of Claims 1 3, 6, and 8-11 under 35 U.S.C. Section 103(a) as Being Unpatentable Over O'Connell, Silverman et al., and Official Notice.**

**1. The Examiner Has Failed to Present a Prima Facie Case of Obviousness.**

To establish a *prima facie* case of obviousness, the Examiner must provide clear articulation of reason(s) why the claimed invention would have been obvious. See MPEP Section 2143. There must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR v. Teleflex, 127 S. Ct. 1727, 1741 (citing to the Federal Circuit statement with approval). More specifically, the Examiner needs to articulate that there is some suggestion or motivation to modify the prior art, that

there is a reasonable expectation of success, and that the prior art reference (or references when combined) teaches or suggests all the claim limitations. Indeed, simply identifying all of the elements in a claim in the prior art does not render a claim obvious. Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275 (Fed. Cir. 2004).

**a. Separate Argument for Claim 1.**

The Examiner has failed to provide a *prima facie* case of obviousness of Independent Claim 1 under 35 U.S.C. Section 103(a) based on the O'Connell reference, the Silverman et al. reference, and Official Notice. It is asserted that when properly construed (and it is expressly conceded by the Examiner), that the O'Connell and Silverman et al. references fail to teach or suggest all the limitations of the present invention. With regard to the majority of Claim 1, comprising three paragraphs and no less than six (6) steps, the Examiner has not provided any prior art whatsoever, relying instead on an invalid use of "Official Notice."

The pertinent portion of the O'Connell reference is brief, and it is quoted in its entirety herein:

"Bacardi tried some cable-TV advertising in the U.S. last year with a spot featuring three men going to a party at a hip locale where there were plenty of sexy women. That spot showed the Bacardi icon and directed viewers to a Web site. Paul Francis, a senior marketing manager at Bacardi, says the idea behind the ad was to get consumers to think of Bacardi as hip and cool, and lure them online."



Thus, O'Connell is cited to teach **a TV ad with a web address and a website associated with the web address**. There is absolutely no indication in the O'Connell reference of what content the website may have had. The O'Connell reference is asserted with respect to the "enhancing" paragraph of Claim 1 (lines 3 and 4) and the "providing a marketing website" paragraph of Claim 1 (lines 5 and 6).

The pertinent portion of the Silverman et al. reference is also brief, and is quoted in its entirety herein:

"In the Hotjobs Super Bowl commercial, a silver click-click gravity ball that swings on a string rolls off an employee's desk. As viewers hear the group The Mamas and the Papas singing "Go Where You Want to Go," the ball joins a game of marbles being played in a park. The ad suggests viewers can "control their own destinies and follow their own optimistic dream," Mr. Johnson says. The tagline: "Onward. Upward."

"Hotjobs also has created a video-game version of its commercials that enables users to guide the runaway silver ball through a maze. Users can e-mail the Hotjobs-branded game to friends."

Thus, Silverman et al. reference is cited to teach **a video game that is associated with a TV ad**. There is absolutely no indication of where the game comes from, but rather only that it is a computer video game that can be e-mailed. No mention whatsoever is made of a website, or of the game itself being on a website. While an inference may be drawn that the game was downloaded, it could just as easily have been provided on a floppy disk or CD-ROM instead. The Silverman et al. reference is asserted with respect to the "providing a game or contest" paragraph of Claim 1 (lines 19-21).

This leaves three (3) paragraphs (each containing two (2) steps) of Claim 1 that have absolutely no prior art cited against them:

**"displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a list of television networks on which enhanced television commercials have aired, and prompting the consumer to select the particular television network on which the consumer viewed the particular enhanced television commercial;**

**"displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows enhanced television commercials have been broadcasted, and prompting the consumer to select the particular television show during which the consumer viewed the particular enhanced television commercial;**

**"displaying to the consumer a list of enhanced television commercials which were broadcasted during the particular television show, and prompting the consumer to select the particular enhanced television commercial;"**

The Examiner's own words in this regard are particularly damning:

"O'Connell is also silent about displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a list of television networks on which enhanced television commercials have aired, and prompting the consumer to select the particular television network on which the consumer viewed the particular enhanced television commercial; displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows enhanced television commercials have been broadcasted, and prompting the consumer to select the particular television show during which the consumer viewed the particular enhanced television commercial; displaying to the consumer a list of enhanced television commercials which were broadcasted during the particular television show, and prompting the consumer to select the particular enhanced television commercial. In reference to claims 1 and 11, Official Notice is taken that it is old and well known to ask consumers how they reached the sponsor's

website or store location and where and which commercial did the consumer see that referred the consumer to the sponsor's website or store location to help the sponsor determine what type of advertising is reaching its target audience and where the sponsor should invest future advertising dollars. For example, when a user visits a Management Property, he is asked to fill out an informational card telling the Property Management staff who referred the user to the property and which advertising sources did the user utilize to find this community. Another example is a recruiting company that also asks job candidates through what medium did they hear about the firm and if someone referred them to the company both in person during an interview and online when the user fills out a questionnaire and posts his resume. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in O'Connell's invention, the use of questions on the sponsor's website where the user makes a response selection by placing a cursor on of a mouse on a desired location and clicking on that location with the mouse to make the choice selection to obtain information from the consumer to assist the sponsor in determining where to best spend his advertising dollars to reach his target audience and to determine what sources are being utilized by the target audience to reach the sponsor." December 7, 2007, Office Action, pages 4-6.

The use of "Official Notice" to show these six (6) steps without citing any reference to do so is both misplaced and completely erroneous. It is clearly in violation of proper procedure. "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of **instant and unquestionable demonstration as being well-known. ... It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record,** as the principal evidence upon which a rejection was based. In Re Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ('[T]he Board **cannot simply reach**

**conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense.** Rather, the Board must point to some **concrete evidence in the record in support of these findings.**')." MPEP Section 2144.03, emphasis added. Since the rejection of Claim 1 on the merits relies upon such unsupportable Official Notice, this rejection is clearly improper, and must be withdrawn.

Since the rejection of Claim 1 is characterized by the improper reliance upon "Official Notice" to supply the vast portion of the claims (six (6) steps), and since no prior art has been identified to teach these six (6) steps, the rejection of Claim 1 is both nonstatutory and deficient and utterly fails to present a *prima facie* obviousness rejection. Specifically, nothing in cited prior art teaches the following steps:

1. "displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a list of television networks on which enhanced television commercials have aired;"
2. "prompting the consumer to select the particular television network on which the consumer viewed the particular enhanced television commercial;"
3. "displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows enhanced television commercials have been broadcasted;"

4. "prompting the consumer to select the particular television show during which the consumer viewed the particular enhanced television commercial;"
5. "displaying to the consumer a list of enhanced television commercials which were broadcasted during the particular television show;" and
6. "prompting the consumer to select the particular enhanced television commercial."

The position of the December 7, 2007, Office Action is that all of these limitations of Claim 1 are somehow miraculously obvious in view of the incorrect application of "Official Notice" to teach what the prior art does not in fact teach. The implicit admission in the failure of the December 7, 2007, Office Action to cite any prior art is that no prior art applicable to these limitations was located. The Examiner has addressed the Appellant's objections to the invalid use of Official Notice to teach the majority of the steps contained in Claim 1 by a feeble attempt to switch the burden of proof to Appellant, by asserting that Appellant must submit a "rebuttal of the well known statements."

It is beyond question that the burden in establishing a rejection that the burden is on the Examiner, and it is also beyond question that the Examiner's statement that Appellant somehow has a burden of rebutting the Examiner's completely unsupported assertion that no less than six (6) steps are well known in the art is absolutely, positively wrong. **"It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference**

**where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. ... It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. In Re Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697.**

Emphasis added. Accordingly, the burden is on the Examiner to establish that the six (6) steps are well known, when it is clear that they are not.

By the Examiner's misbegotten and improper standard, any element(s) of any claim in any technology could be rejected by the completely unsupported use of Official Notice, and the Examiner would be able to defend such a rejection by asserting that Appellant somehow had an obligation to rebut blanket statements that were completely unsupported by any prior art. Appellant submits that this is absolutely incorrect, and that the Examiner has completely ignored binding legal requirements of the statutes and regulations, the case law, and the MPEP. This wrong-headed position is clearly visible for what it is -- an absolute failure to present a *prima facie* case of obviousness. Accordingly, since the rejection of Claim 1 so clearly fails to present a *prima facie* case of obviousness, it is apparent that this rejection is erroneous, and must be removed. Similarly, the rejections of Claims 3, 6, and 8-11, each of which are dependent upon Claim 1, on the same deficient grounds are also erroneous and must be removed, and the rejections of

dependant claims 4, 5, 7, and 12-24, which are rejected on other grounds but which also depend from allowable Claim 1, must also be removed.

**B. The Rejection of Claim 7, and the inferential rejection of Claim 4, Under 35 U.S.C. Section 112, Second Paragraph.**

**1. Claims 4 and 7 Particularly Point Out and Distinctly Claim the Subject Matter Contained Therein.**

**a. Separate Argument for Claim 4.**

The Examiner stated in Paragraph 5 on Page 2 on the December 7, 2007, Office Action that "there was no mention of printable material in claim 1 from which this claim depends." This appears to be an antecedent basis assertion under 35 U.S.C. Section 112, second paragraph. Claim 4 reads as follows:

"4. (Original) A method as defined in Claim 1, additionally comprising:  
"enhancing printed materials which are transmitted to consumers by  
printing said marketing website logo thereupon."

There was no mention of printable material in Claim 1, from which Claim 4 depends for a very simple reason – namely that Claim 4 contains a wholly new step which is additional to the steps contained in Claim 1. Thus, since it is an additional step, it is entirely appropriate that there would be no mention of printable material in Claim 1.

Claim 4 is thus entirely proper and should not remain under the shadow cast by the inappropriate comment in the December 7, 2007, Office Action.

**a. Separate Argument for Claim 7.**

The Examiner stated in Paragraph 6 on Pages 2-3 of the December 7, 2007, Office Action that "the claim recites, 'displaying, simultaneously with said step of displaying a list of television networks, a readily recognizable logo or other indicia that identifies said type of printed material.' This limitation is unclear. Specifically, it is unclear how a logo itself identifies the type of printed material. A logo can be placed on a printed publication and on a website simultaneously, but the logo itself is not identifying the type of printed material. It is interpreted that the Applicant is trying to claim a limitation that a printed material is printed with a logo and that logo is also displayed on a website."

Claim 7 reads as follows:

"7. (Previously Presented) A method as defined in Claim 6, additionally comprising:

"printing said marketing website logo on at least one type of printed material which is provided to consumers; and

"displaying, simultaneously with said step of displaying a list of television networks, a readily recognizable logo or other indicia that identifies said type of printed material."



Appellant submits that this claim is clear and precise when read in the context of the specification and drawings; see paragraph 61 of the specification, which states:

**"[A] biller logo 102 is also illustrated in Fig. 8, which may be used to indicate that it is a paper communication bearing the marketing website logo 66 which originated with the biller** who sent the consumer the particular bill which prompted the consumer to log on to the third party marketing website 58." Emphasis added.

FIG. 8 also clearly shows the biller logo 102. The use of the specification and drawings to interpret this claim is sanctioned by the Federal Circuit, which stated in an *en banc* decision in Phillips v. AWH Corp., 415 F.3d 1303, 1315, 75 USPQ2d 1321, 1327 (in part quoting from the Supreme Court's Markman decision) as follows:

"The claims, of course, do not stand alone. Rather, they are part of 'a fully integrated written instrument,' Markman, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims 'must be read in view of the specification, of which they are a part.' *Id.* at 979. As we stated in Vitronics, the specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.' 90 F.3d at 1582."

Displaying the biller logo 102, which clearly shows a depiction of a bill, which is "one type of printed material which is provided to consumers." Accordingly, Appellant submits that Claim 7 is clear and precise when read in the context of the specification and drawings, as required by both the Supreme Court and the Federal Circuit, and request that the Section 112, second paragraph, rejection of Claim 7 be removed.

**C. The Rejection of Claims 4, 5, and 7 under 35 U.S.C. Section 103(a) as Being Unpatentable Over O'Connell, Silverman et al., Monster.com, and Official Notice.**

**1. The Examiner Has Failed to Present a Prima Facie Case of Obviousness.**

**a. Separate Argument for Claim 4.**

The Examiner has failed to provide a *prima facie* case of obviousness of dependent Claim 4 under 35 U.S.C. Section 103(a) based on the O'Connell reference, the Silverman et al. reference, the Monster.com reference, and Official Notice.

As discussed above, the O'Connell and Silverman et al. references fail to teach or suggest the limitations of Claim 4 that are contained in Claim 1, upon which Claim 4 is dependent. With regard to the three paragraphs and six (6) steps of Claim 1 that are incorporated in Claim 4, the Examiner has not provided any prior art whatsoever, relying instead on "Official Notice." The Monster.com reference was cited to teach the further

step taught in Claim 4, which are "enhancing printed materials which are transmitted to consumers by printing said marketing website logo thereupon."

The Monster.com reference consists of a single page printout (while the December 7, 2007, Office Action references attached pages, only a single page is available via Pair) that appears to be a web page only. There is no indication whatsoever of any printed material in this reference. While the website depicted in the Monster.com reference does indeed bear the Monster.com logo, it most certainly is not a printed material, and thus the Monster.com reference clearly does not teach in any way what the December 7, 2007, Office Action indicates that it teaches, and it certainly does not teach the limitations that are included in Claim 4. Since the rejection of Claim 4 fails to present a *prima facie* case of obviousness, it is apparent that this rejection is erroneous, and must be removed. Similarly, the rejection of Claim 5, which is dependent upon Claim 4, on the same deficient grounds, is also erroneous and must be removed.

**a. Separate Argument for Claim 7.**

The Examiner has failed to provide a *prima facie* case of obviousness of dependent Claim 7 under 35 U.S.C. Section 103(a) based on the O'Connell reference, the Silverman et al. reference, the Monster.com reference, and Official Notice.

As discussed above, the O'Connell and Silverman et al. references fail to teach or suggest the limitations of Claim 7 that are contained in Claim 1, upon which Claim 7 is dependent. With regard to the three paragraphs and six (6) steps of Claim 1 that are

incorporated in Claim 7, the Examiner has not provided any prior art whatsoever, relying instead on "Official Notice." The Monster.com reference was cited to teach the further steps taught in Claim 7, which are "printing said marketing website logo on at least one type of printed material which is provided to consumers," and "displaying, simultaneously with said step of displaying a list of television networks, a readily recognizable logo or other indicia that identifies said type of printed material."

The single page printout of the Monster.com reference consists of a web page only. There is no indication in the Monster.com reference whatsoever of any printed material. While the website depicted in the Monster.com reference does indeed bear the Monster.com logo, it is not a printed material, and thus the Monster.com reference clearly does not teach what the December 7, 2007, Office Action indicates that it teaches, and it certainly does not teach the first additional limitation that is included in Claim 7. For this reason alone, the rejection of Claim 7 is invalid and must be withdrawn.

Additionally, the Examiner falls back on Official Notice with regard to the second additional limitation of Claim 7, stating:

"Official Notice is also taken that it is old and well known to present the same logo on a television network display list also on printed materials as done by cable broadcasting companies that are trying to promote a network that is offered by the broadcasting company in form of a flyer that is sent to user's home with that network's logo on it as well as the display of that network's logo on the channel preview channel. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in O'Connell's invention the use same logo on the television network as the one on printed materials regarding Bacardi to

enable the users to recognize the Bacardi brand easily by the use of the logo in both instances." December 7, 2007, Office Action, page 9.

The use of Official Notice to show this additional step without citing any reference to do so is erroneous and in clear violation of proper procedure. "[T]he Board **cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense.** Rather, the Board must point to some **concrete evidence in the record in support of these findings.**" In Re Zurko, supra. Since the rejection of Claim 7 relies upon such unsupportable Official Notice, this rejection is clearly erroneous, and must be removed.

**D. The Rejection of Claims 12-26 under 35 U.S.C. Section 103(a) as Being Unpatentable Over O'Connell, Silverman et al., Lesandrini et al., and Official Notice.**

**1. The Examiner Has Failed to Present a Prima Facie Case of Obviousness.**

**a. Separate Argument for Claims 12-24.**

The Examiner has failed to provide a *prima facie* case of obviousness of dependent Claims 12-24 under 35 U.S.C. Section 103(a) based on the O'Connell reference, the Silverman et al. reference, the Lesandrini et al. reference, and Official Notice.

The pertinent portion of the Lesandrini et al. reference is brief, and is quoted in its entirety herein:

"[0137] Online Games

"[0138] The site will feature a number of online games, bringing in elements from the commercials that are on the site. These games will also earn users points and will prompt users to view commercials to complete various games. For example, one game may be a "where are they now?" trivia game, in reference to popular characters in advertisements. AS mentioned before, another example is illustrated in FIG. 12, called Mascot Mania. Participants are asked to select the correct name of the mascot, the brand, the company, and the type of product it represents."

Fig. 12 "is an illustration of a game." Page 3, paragraph 53, from the Brief Description of the Drawing[s]." The Lesandrini et al. reference apparently allows one to choose between a number of different games. The Lesandrini et al. reference is also cited as teaching determining whether a consumer has previously registered (which is apparently a reference to the member log in displayed in Fig. 7).

With reference to Claims 17-19 and 23, all of which depend from Claim 1, no specific mention of the Lesandrini et al. reference is made at all. As discussed in detail above, the O'Connell and Silverman et al. references fail to teach or suggest the limitations of dependent Claims 12-24 that are contained in Claim 1, upon which Claims

12-24 are ultimately dependent. With regard to the three (3) paragraphs and six (6) steps of Claim 1 that are incorporated in each of dependent Claims 12-24, the Examiner has not pointed to any content of the Lesandrini et al. reference to teach these six (6) steps or otherwise provided any prior art whatsoever, relying instead only on "Official Notice." Since the Lesandrini et al. reference was not cited to teach any of the limitations (and indeed does not teach any of the limitations) taught in the three (3) paragraphs and six (6) steps of Claim 1 that are incorporated in each of Claims 12-24, each and every one of these dependent claims thereby also include the six (6) steps of Claim 1 therein for which no prior art was cited. Thus, the rejections of Claims 12-24 fail to present a *prima facie* case of obviousness, and it is apparent that these rejections are erroneous, and must be withdrawn.

**b. Separate Argument for Claim 25.**

The Examiner has failed to provide a *prima facie* case of obviousness of Independent Claim 25 under 35 U.S.C. Section 103(a) based on the O'Connell reference, the Silverman et al. reference, the Lesandrini et al. reference, and Official Notice. It is asserted that when properly construed (and it is expressly conceded by the Examiner), the O'Connell, Silverman et al., and Lesandrini et al. references fail to teach or suggest all the limitations of the present invention. (The Lesandrini et al. reference is not discussed at all in the specific rejection of Claim 25 on pages 15-17 of the December 7, 2007, Office Action.)

The O'Connell reference is cited to teach a TV ad with a web address and a website associated with the web address (although there is absolutely no indication in the O'Connell reference of what content the website may have had). The O'Connell reference is asserted with respect to the "displaying" paragraph of Claim 25 (line 3) and the "providing a marketing website" paragraph of Claim 25 (lines 4 and 5).

The Silverman et al. reference is cited to teach a video game that is associated with a TV ad (although there is no indication of where the computer video game comes from, and no mention is made of a website, or of the game itself being on a website, but only that it is a game that can be e-mailed). The Silverman et al. reference is asserted with respect to the "providing a game or contest" paragraph of Claim 25 (lines 20-22).

With regard to the majority of Claim 25, comprising three (3) paragraphs and no less than six (6) steps, the Examiner has not provided any prior art whatsoever, relying instead on "Official Notice." This reliance is improper. "[T]he Board **cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense.** Rather, the Board must point to some **concrete evidence in the record in support of these findings.**" In Re Zurko, supra. As such, since no prior art has been identified to teach these six (6) steps, the rejection of Claim 25 is both nonstatutory and deficient and utterly fails to present a *prima facie* obviousness rejection. Specifically, nothing in cited prior art teaches the following steps:



1. "displaying to a consumer who has entered said marketing website in response to viewing the television commercial a list of television networks on which television commercials which display said marketing website logo have been broadcasted;"
2. "prompting the consumer to select the television network on which the consumer viewed the television commercial;"
3. "in response to the consumer's selection of a particular television network, displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows television commercials which display said marketing website logo have been broadcasted;"
4. "prompting the consumer to select the television show during which the consumer viewed the television commercial;"
5. "in response to the consumer's selection of a particular television show, displaying to the consumer a list of television commercials which display said marketing website logo and which were broadcasted during the selected television show;"  
and
6. "prompting the consumer to select the television commercial."

The position of the December 7, 2007, Office Action that all of these limitations of Claim 25 are present through the incorrect application of "Official Notice" to teach what the prior art does not teach is clearly erroneous. The December 7, 2007, Office Action thus completely failed to cite any prior art applicable to these six (6) limitations.

Accordingly, since the rejection of Claim 25 fails to present a *prima facie* case of obviousness, it is apparent that this rejection is erroneous, and must be removed.

**c. Separate Argument for Claim 26.**

The Examiner has failed to provide a *prima facie* case of obviousness of Independent Claim 26 under 35 U.S.C. Section 103(a) based on the O'Connell reference, the Silverman et al. reference, the Lesandrini et al. reference, and Official Notice. When properly construed (and as expressly conceded by the Examiner), the O'Connell, Silverman et al., and Lesandrini et al. references fail to teach or suggest all the limitations of the present invention. (The Lesandrini et al. reference is not discussed at all in the specific rejection of Claim 26 on pages 18-20 of the December 7, 2007, Office Action.)

The O'Connell reference is cited to teach a TV ad with a web address and a website associated with the web address (although there is absolutely no indication in the O'Connell reference of what content the website may have had). The O'Connell reference is asserted with respect to the "enhancing" paragraph of Claim 26 (lines 3 and 4) and the "providing a marketing website" paragraph of Claim 26 (lines 5 and 6).

The Silverman et al. reference is cited to teach a video game that is associated with a TV ad (although there is no indication of where the computer video game comes from, and no mention is made of a website, or of the game itself being on a website, but only that it is a game that can be e-mailed). The Silverman et al. reference is asserted with respect to the "providing a game or contest" paragraph of Claim 26 (lines 21-24).

With regard to the majority of Claim 26, comprising three (3) paragraphs and no less than six (6) steps, the Examiner has not provided any prior art whatsoever, relying instead on "Official Notice." This reliance is improper. "[T]he Board **cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense.** Rather, the Board must point to some **concrete evidence in the record in support of these findings.**" In Re Zurko, supra. As such, since no prior art has been identified to teach these six (6) steps, the rejection of Claim 26 is both nonstatutory and deficient and utterly fails to present a *prima facie* obviousness rejection. Specifically, nothing in cited prior art teaches the following steps:

1. "displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a list of television networks on which enhanced television commercials have aired;"
2. "prompting the consumer to select the particular television network on which the consumer viewed the particular enhanced television commercial;"
3. "in response to the consumer's selection of a particular television network, displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows enhanced television commercials have been broadcasted;"

4. "prompting the consumer to select the particular television show during which the consumer viewed the particular enhanced television commercial;
5. "in response to the consumer's selection of a particular television show, displaying to the consumer a list of enhanced television commercials which were broadcasted during the particular television show; and
6. "prompting the consumer to select the particular enhanced television commercial."

The position of the December 7, 2007, Office Action that all of these limitations of Claim 26 are present through the incorrect application of "Official Notice" to teach what the prior art does not teach is clearly erroneous. The December 7, 2007, Office Action thus completely failed to cite any prior art applicable to these six (6) limitations. Accordingly, since the rejection of Claim 26 fails to present a *prima facie* case of obviousness, it is apparent that this rejection is erroneous, and must be removed.

**E. The Rejection of Claim 27 under 35 U.S.C. Section 103(a) as Being Unpatentable Over O'Connell, Silverman et al., the Monster.com Reference, and Official Notice.**

**1. The Examiner Has Failed to Present a Prima Facie Case of Obviousness.**

**a. Separate Argument for Claim 27.**

The Examiner has failed to provide a *prima facie* case of obviousness of Independent Claim 27 under 35 U.S.C. Section 103(a) based on the O'Connell reference, the Silverman et al. reference, the Monster.com reference, and Official Notice. When properly construed (and as expressly conceded by the Examiner), the O'Connell, Silverman et al., and Monster.com references fail to teach or suggest all the limitations of the present invention.

The O'Connell reference is cited to teach a TV ad with a web address and a website associated with the web address (although there is absolutely no indication in the O'Connell reference of what content the website may have had). The O'Connell reference is asserted with respect to the "providing a marketing website" paragraph of Claim 27 (lines 3 and 4) and the "enhancing" paragraph of Claim 27 (lines 5-7).

The Silverman et al. reference is cited to teach a video game that is associated with a TV ad (although there is no indication of where the computer video game comes from, and no mention is made of a website, or of the game itself being on a website, but only

that it is a game that can be e-mailed). The Silverman et al. reference is asserted with respect to the "providing a game or contest" paragraph of Claim 27 (lines 21-24).

The Monster.com reference, which consists of a web page (there is no indication in the Monster.com reference whatsoever of any printed material) that bears the Monster.com logo., has been asserted to teach providing "marketing information relating to the product advertised by the particular enhanced television commercial viewed by the consumer in a manner which is associated with said incentives." December 7, 2007, Office Action, page 21. The Monster.com reference is asserted with respect to the "providing incentives" paragraph of Claim 27 (lines 8-9) and the "providing marketing information" paragraph of Claim 27 (lines 14-16).

With regard to the former, the relevant paragraph requires "providing incentives to motivate customers to enter said marketing website in response to viewing enhanced television commercials." The Examiner's assertion that the Monster.com reference provides marketing information "in a manner which is associated with said incentives" grossly misrepresents the Monster.com reference, which does nothing of the sort. Fairly construed, the single page Monster.com reference does not even have an inference relating to incentives. Since the Monster.com reference does not teach this limitation, the references cited in the rejection of Claim 27 has no teaching of this feature whatsoever, and thus the rejection fails to provide a *prima facie* basis for the rejection.

Additionally, with regard to one paragraph of Claim 27, the Examiner has not provided any prior art whatsoever, relying instead on "Official Notice." The rejection of Claim 26 is characterized by improper reliance upon "Official Notice" to supply this portion of the claim. "[T]he Board **cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense.** Rather, the Board must point to some **concrete evidence in the record in support of these findings.**" In Re Zurko, supra. As such, since no prior art has been identified to teach this step, the rejection of Claim 26 is both nonstatutory and deficient and utterly fails to present a *prima facie* obviousness rejection. Specifically, nothing in cited prior art teaches the following step:

"displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a series of screens which prompt the consumer to select the particular enhanced television commercial viewed by the consumer."

The position of the December 7, 2007, Office Action that this limitation of Claim 27 is present through the incorrect application of "Official Notice" to teach what the prior art does not teach is clearly erroneous. The December 7, 2007, Office Action thus completely failed to cite any prior art applicable to this limitation. Accordingly, since the rejection of Claim 27 again fails to present a *prima facie* case of obviousness, it is apparent that this rejection is erroneous, and must be removed.

**F. The Rejection of Claim 28 under 35 U.S.C. Section 103(a) as Being Unpatentable Over O'Connell, the Monster.com Reference, and Official Notice.**

**1. The Examiner Has Failed to Present a Prima Facie Case of Obviousness.**

**a. Separate Argument for Claim 28.**

The Examiner has failed to provide a *prima facie* case of obviousness of Independent Claim 27 under 35 U.S.C. Section 103(a) based on the O'Connell reference, the Monster.com reference, and Official Notice. When properly construed (and as expressly conceded by the Examiner), the O'Connell and Monster.com references fail to teach or suggest all the limitations of the present invention.

The O'Connell reference is cited to teach a TV ad with a web address and a website associated with the web address (although there is absolutely no indication in the O'Connell reference of what content the website may have had). The O'Connell reference is asserted with respect to the "providing a marketing website" paragraph of Claim 28 (line 2) and the "broadcasting" paragraph of Claim 28 (lines 3-4).

The Monster.com reference, which consists of a web page (there is no indication in the Monster.com reference whatsoever of any printed material) that bears the Monster.com logo, has been asserted to teach "providing marketing information relating to the product advertised by the particular enhanced television commercial viewed by the consumer in a manner which is associated with the consumer finds gratifying to satisfy



the consumer's desire for more information and to provide an interactive and user friendly experience for the user who is seeking out this additional information." December 7, 2007, Office Action, page 24. The Monster.com reference is asserted with respect to the "providing marketing information" paragraph of Claim 28 (lines 11-13), although Appellant cannot find anything in the single page Monster.com reference that any consumer would provide gratifying, far less "provide an interactive and user friendly experience for the user."

Additionally, with regard to three paragraphs of Claim 28, the Examiner has not provided any prior art whatsoever, relying instead on "Official Notice." The rejection of Claim 28 is characterized by improper reliance upon "Official Notice" to supply this portion of the claim. "[T]he Board **cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense.** Rather, the Board must point to some **concrete evidence in the record in support of these findings.**" In Re Zurko, supra. As such, since no prior art has been identified to teach these steps, the rejection of Claim 28 is both nonstatutory and deficient and utterly fails to present a *prima facie* obviousness rejection. Specifically, nothing in cited prior art teaches the following three (3) steps:

1. "allowing a consumer entering said marketing website to select the particular television network on which the consumer viewed a particular one of said plurality of television commercials;"

2. "allowing the consumer to select the particular television show during which the consumer viewed said particular television commercial;" and
3. "allowing the consumer to select said particular television commercial."

The position of the December 7, 2007, Office Action that these limitations of Claim 28 are present through the incorrect application of "Official Notice" to teach what the prior art does not teach is clearly erroneous. The December 7, 2007, Office Action thus completely failed to cite any prior art applicable to these three (3) limitation. Accordingly, since the rejection of Claim 28 fails to present a *prima facie* case of obviousness, it is apparent that this rejection is erroneous, and must be removed.

**Conclusion**

For the foregoing reasons, Appellant respectfully requests that each of the obviousness rejections advanced in the Office Action dated December 7, 2007, be reversed and withdrawn and that the Application be permitted to move forward toward issuance.

Respectfully submitted:

BY /Leslie S. Miller/  
Leslie S. Miller  
Attorney for Appellant  
Registration No. 30,662

Reinhart Boerner Van Deuren s.c.  
1000 North Water Street, Suite 2100  
Milwaukee, WI 53202

(414) 298-8321

Customer No. 22922

**VIII. Claims Appendix**

1. (Original) A method of increasing consumer awareness of products or services which are advertised in television commercials, comprising:

- enhancing a plurality of television commercials by displaying a marketing website logo during each of said plurality of enhanced television commercials;
- providing a marketing website which is associated with and identified by said marketing website logo and which is accessible by consumers;
- displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a list of television networks on which enhanced television commercials have aired, and prompting the consumer to select the particular television network on which the consumer viewed the particular enhanced television commercial;
- displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows enhanced television commercials have been broadcasted, and prompting the consumer to select the particular television show during which the consumer viewed the particular enhanced television commercial;
- displaying to the consumer a list of enhanced television commercials which were broadcasted during the particular television show, and prompting the consumer to select the particular enhanced television commercial; and

19 providing a game or contest for the consumer to play which game or contest  
20 provides information on or relates to the particular product or service advertised by the  
21 particular enhanced television commercial.

1 2. (Original) A method as defined in Claim 1, wherein said enhancing step  
2 comprises:  
3 placing said marketing website logo in a prominent position during at least a  
4 portion of each of said television commercials.

1 3. (Original) A method as defined in Claim 1, wherein said marketing website logo  
2 comprises:  
3 the Universal Resource Locator ("URL") address of said marketing website; and  
4 a stylized logo which contains said URL address of said marketing website.

1 4. (Original) A method as defined in Claim 1, additionally comprising:  
2 enhancing printed materials which are transmitted to consumers by printing said  
3 marketing website logo thereupon.

1 5. (Original) A method as defined in Claim 4, wherein said printed materials  
2 comprise at least one of the group consisting of:  
3 billing statements, print advertisements, telephone advertisements, and billboards.

1     6.     (Original) A method as defined in Claim 1, wherein said step of displaying a list of  
2     television networks comprises:

3             displaying a readily recognizable logo for each of said television networks on  
4     which at least one enhanced television commercial has aired.

1     7.     (Previously Presented) A method as defined in Claim 6, additionally comprising:  
2             printing said marketing website logo on at least one type of printed material which  
3     is provided to consumers; and

4             displaying, simultaneously with said step of displaying a list of television  
5     networks, a readily recognizable logo or other indicia that identifies said type of printed  
6     material.

1     8.     (Original) A method as defined in Claim 1, wherein said step of displaying a list of  
2     television shows comprises:

3             displaying a readily recognizable name or logo for each of said television shows  
4     during which at least one enhanced television commercials has aired.

1     9.     (Original) A method as defined in Claim 1, wherein said step of displaying a list of  
2     enhanced television commercials comprises:

displaying a separate information element associated with each enhanced television commercial which was broadcasted.

10. (Original) A method as defined in Claim 9, wherein said information element comprises:

at least one item selected from the group consisting of the name of a company which manufactures or sells a product or service being advertised, a model name or number of a product or service being advertised, and information about a prize being awarded in said game or contest.

11. (Original) A method as defined in Claim 1, wherein said prompting steps lead the consumer to make the appropriate selection by placing a cursor of a mouse on a desired location and clicking a button of the mouse to make the selection.

12. (Original) A method as defined in Claim 1, additionally comprising:  
obtaining demographic information from the consumer.

13. (Original) A method as defined in Claim 12, wherein said obtaining step comprises:  
obtaining information about the consumer regarding at least two items from the group consisting of the consumer's gender, the consumer's age, the consumer's

5 relationship status, the consumer's residential occupancy type, the consumer's zip code,  
6 the consumer's salary bracket or household income, the consumer's household size, and  
7 the consumer's television viewing or radio listening habits.

1 14. (Original) A method as defined in Claim 1, additionally comprising:  
2 requiring each consumer accessing said marketing website to register by providing  
3 certain information prior to said providing step.

1 15. (Original) A method as defined in Claim 14, wherein said information comprises:  
2 at least two items from the group consisting of the consumer's name, the  
3 consumer's e-mail address, the consumer's address, and the consumer's zip code.

1 16. (Original) A method as defined in Claim 14, wherein said requiring step  
2 comprises:  
3 determining whether the consumer has previously registered;  
4 if the consumer has previously registered, requiring the consumer to log in; and  
5 if the consumer has not previously registered, requiring the consumer to register.

1 17. (Original) A method as defined in Claim 1, wherein said providing step comprises:  
2 providing to the consumer the game or contest related to the particular product or  
3 service advertised by the particular enhanced television commercial; and



4           upon completion of the game or contest related to the particular product or service  
5   advertised by the particular enhanced television commercial, providing to the consumer  
6   the consumer's score or standing.

1   18.   (Original) A method as defined in Claim 17, wherein said providing step  
2   additionally comprises:

3           providing to the consumer the option to be notified of the final game or contest  
4   results and allowing the consumer to select said option.

1   19.   (Original) A method as defined in Claim 18, wherein if the consumer has selected  
2   the option to be notified of the final game or contest results, said notification is provided  
3   by one of the delivery mechanisms selected from the group consisting of e-mail, voice  
4   e-mail, pager alert, wireless e-mail, or by providing a toll-free telephone number.

1   20.   (Previously Presented) A method as defined in Claim 1, wherein said providing  
2   step comprises:

3           displaying to the consumer a plurality of additional games or contests which can  
4   be played;

5           prompting the consumer to select at least one additional game or contest to be  
6   played;

7           upon selection by the consumer of such additional game(s) or contest(s) to be  
8   played, or the consumer declining to do so, providing to the consumer the game or  
9   contest related to the particular product or service advertised by the particular enhanced  
10   television commercial; and  
11           if the consumer has selected an additional game(s) or contest(s), following  
12   completion of the game or contest related to the particular product or service advertised  
13   by the particular enhanced television commercial, providing to the additional game(s) or  
14   contest(s) selected.

1   21.   (Original) A method as defined in Claim 20, wherein said additional games or  
2   contests are related to products or services which in turn are related to the particular  
3   product or service advertised by the particular enhanced television commercial.

1   22.   (Original) A method as defined in Claim 20, further comprising:  
2           delivering a coupon to the consumer following the completion of at least one of  
3   the additional games, wherein said coupon may be printed by said consumer.

1   23.   (Original) A method as defined in Claim 1, wherein said game or contest  
2   comprises:

3 a game or contest in which the consumer is required to provide information from  
4 the particular enhanced commercial, and the scoring for such game or contest is based  
5 upon the degree to which such information is correctly provided.

1 24. (Original) A method as defined in Claim 1, wherein by obtaining a sufficient score  
2 in said game or contest, the consumer is entered into a drawing for a prize.

1 25. (Original) A method of increasing consumer awareness of a product or service  
2 which is advertised in a television commercial, comprising:

3 displaying a marketing website logo during the television commercial;  
4 providing a marketing website which is associated with and identified by said  
5 marketing website logo and which is accessible by consumers;  
6 displaying to a consumer who has entered said marketing website in response to  
7 viewing the television commercial a list of television networks on which television  
8 commercials which display said marketing website logo have been broadcasted, and  
9 prompting the consumer to select the television network on which the consumer viewed  
10 the television commercial;

11 in response to the consumer's selection of a particular television network,  
12 displaying to the consumer a list of television shows broadcasted by the particular  
13 television network during which television shows television commercials which display

14 said marketing website logo have been broadcasted, and prompting the consumer to  
15 select the television show during which the consumer viewed the television commercial;  
16 in response to the consumer's selection of a particular television show, displaying  
17 to the consumer a list of television commercials which display said marketing website  
18 logo and which were broadcasted during the selected television show, and prompting the  
19 consumer to select the television commercial; and  
20 in response to the consumer's selection of the television commercial, providing a  
21 game or contest for the consumer to play which game or contest provides information on  
22 or relates to the particular product or service advertised by the television commercial.

1 26. (Original) A method of increasing consumer awareness of products or services  
2 which are advertised in television commercials, comprising:  
3 enhancing a plurality of television commercials by displaying a marketing website  
4 logo during each of said plurality of enhanced television commercials;  
5 providing a marketing website which is associated with and identified by said  
6 marketing website logo and which is accessible by consumers;  
7 displaying to a consumer who has entered said marketing website in response to  
8 viewing a particular enhanced television commercial a list of television networks on  
9 which enhanced television commercials have aired, and prompting the consumer to select

the particular television network on which the consumer viewed the particular enhanced television commercial;

in response to the consumer's selection of a particular television network, displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows enhanced television commercials have been broadcasted, and prompting the consumer to select the particular television show during which the consumer viewed the particular enhanced television commercial;

in response to the consumer's selection of a particular television show, displaying to the consumer a list of enhanced television commercials which were broadcasted during the particular television show, and prompting the consumer to select the particular enhanced television commercial; and

in response to the consumer's selection of the particular enhanced television commercial, providing a game or contest in which the consumer may play for a prize or award, which game or contest provides information on or relates to the particular product or service advertised by the particular enhanced television commercial.

27. (Original) A method of enhancing the marketing of products or services which are advertised in television commercials, comprising:

providing a marketing website which is associated with an indicia and which is accessible by consumers;

enhancing a plurality of television commercials by displaying said indicia which is associated with said marketing website during each of said plurality of enhanced television commercials;

providing incentives to motivate consumers to enter said marketing website in response to viewing enhanced television commercials;

displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a series of screens which prompt the consumer to select the particular enhanced television commercial viewed by the consumer; and

providing marketing information relating to the product advertised by the particular enhanced television commercial viewed by the consumer in a manner which is associated with said incentives.

28. (Original) A method of marketing products or services, comprising:

providing a marketing website having a particular web address;

broadcasting said web address in conjunction with each of a plurality of television commercials;

first, allowing a consumer entering said marketing website to select the particular television network on which the consumer viewed a particular one of said plurality of television commercials;

8           second, allowing the consumer to select the particular television show during  
9    which the consumer viewed said particular television commercial;  
10          third, allowing the consumer to select said particular television commercial; and  
11          fourth, providing marketing information relating to the product advertised by the  
12   particular enhanced television commercial in a manner which the consumer finds  
13   gratifying.

**IX. Evidence Appendix**

None.



**X. Related Proceedings Appendix**

None.